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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,926	08/08/2006	G Eric Engstrom	109909-145059	4431
60172 7590 12/15/2008 SCHWABE, WILLIAMSON & WYATT, P.C. 1420 FIFTH, SUITE 3010 SEATTLE, WA 98101			EXAMINER GARY, ERIKA A	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,926	Applicant(s) ENGSTROM ET AL.	
	Examiner Erika A. Gary	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to because of the following informalities: on line 2, "photograph-from" should be "photograph from". Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, and 16 of copending Application No. 10/550,925. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim essentially the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6, 7, 9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Musgrave et al., US Patent Number 6,377,699 (hereinafter Musgrave).

Regarding claims 1 and 7, Musgrave discloses an apparatus comprising: a plurality of components including a component to store a reference photograph; a camera; and operating logic to activate the camera on power-on or reset to take a photograph, receive the photograph, compare the photograph to the stored reference photograph to authenticate a user, and to operate the components depending on whether the user is successfully authenticated based at least in part on said comparison of the photograph to the reference photograph [abstract; col. 2: lines 32-47, 65-67; col. 4: lines 7-15; col. 7: lines 46-67].

Regarding claims 6 and 12, Musgrave discloses the photograph is a photograph selected from the photograph group consisting of a photograph of the user' face, a photograph of an article, and a photograph of an object [col. 7: lines 46-67].

Regarding claim 9, Musgrave discloses saving the reference photograph [col. 7: lines 46-67].

6. Claims 1, 6, 7, 9, 12, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohinata, US Patent application Publication Number 2003/0129964 (hereinafter Kohinata).

Regarding claims 1 and 7, Kohinata discloses an apparatus comprising: a plurality of components including a component to store a reference photograph; a camera; and operating logic to activate the camera on power-on or reset to take a photograph, receive the photograph, compare the photograph to the stored reference photograph to authenticate a user, and to operate the components depending on whether the user is successfully authenticated based at least in part on said comparison of the photograph to the reference photograph [paragraphs 0043-0046, 0049-0051, 0055, 0057-0058, 0063-0064, 0073-0074].

Regarding claims 6 and 12, Kohinata discloses the photograph is a photograph selected from the photograph group consisting of a photograph of the user's face, a photograph of an article, and a photograph of an object [paragraph 0074].

Regarding claim 9, Kohinata discloses saving the reference photograph [paragraph 0051].

Regarding claims 13 and 15, Kohinata discloses a wireless mobile phone comprising: a camera; a plurality of components coupled to each other to facilitate wireless telephony communication by a user, with the components being equipped to

operate in at least a selected one of a first mode and a second mode, the components including a component to store a reference photograph; and operating logic automatically activate the camera, on power-on, to take a photograph, to compare the taken photograph to the reference photograph to authenticate a user, to operate the components in said first mode without authentication of the user, and to operate the components in said second mode if the user is successfully authenticated [paragraphs 0043-0046, 0049-0051, 0055, 0057-0058, 0063-0064, 0073-0074]

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 5, and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Musgrave in view of De Jong, US Patent Number 6,883,716 (hereinafter De Jong).

Regarding claims 4 and 10, Musgrave does not specifically disclose the apparatus further comprises a reader to facilitate provision of the reference photograph from an identity card external to the apparatus, for use to authenticate the user. However, De Jong teaches this limitation [fig. 1; col. 3: lines 13-15; col. 5: lines 21-25, 37-44; col. 6: lines 43-52].

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Musgrave to include De Jong. The motivation for this modification would have been to read the reference authentication information from a separate device to prevent fraudulent use of the apparatus.

Regarding claims 5 and 11, De Jong discloses the reference photograph is stored in said external identity card in a manner to be read by a reader selected from a reader group consisting of an electronic reader, an optical reader and a magnetic reader card [fig. 1; col. 3: lines 13-15; col. 5: lines 21-25, 37-44; col. 6: lines 43-52].

9. Claims 4, 5, 10-11, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohinata in view of De Jong.

Regarding claims 4 and 10, Kohinata does not specifically disclose the apparatus further comprises a reader to facilitate provision of the reference photograph from an identity card external to the apparatus, for use to authenticate the user. However, De Jong teaches this limitation [fig. 1; col. 3: lines 13-15; col. 5: lines 21-25, 37-44; col. 6: lines 43-52].

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Kohinata to include De Jong. The motivation for this modification would have been to read the reference authentication information from a separate device to prevent fraudulent use of the apparatus.

Regarding claims 5 and 11, De Jong discloses the reference photograph is stored in said external identity card in a manner to be read by a reader selected from a

reader group consisting of an electronic reader, an optical reader and a magnetic reader card [fig. 1; col. 3: lines 13-15; col. 5: lines 21-25, 37-44; col. 6: lines 43-52].

Regarding claims 14 and 16, Kohinata discloses the operating logic enables the components to provide first one or more functions while operating the components in said first mode, including retrieval of the reference photograph, and further enables the components to provide second additional one or more functions, while operating the components in said second mode [paragraphs 0043-0046, 0049-0051, 0055, 0057-0058, 0063-0064, 0073-0074].

What Kohinata does not specifically disclose is that the reference photograph is retrieved from an identity card external to the wireless mobile phone. However, De Jong teaches this limitation [fig. 1; col. 3: lines 13-15; col. 5: lines 21-25, 37-44; col. 6: lines 43-52].

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Kohinata to include De Jong. The motivation for this modification would have been to read the reference authentication information from a separate device to prevent fraudulent use of the apparatus.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 4-7, and 9-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EAG/

December 9, 2008

/Erika A. Gary/

Primary Examiner, Art Unit 2617